

### **REMARKS**

The Examiner's comments from the Office Action mailed April 30, 2008 have been carefully considered. Claims 1-48 and 51-55 remain pending in the application. An editorial revision has been made to claim 1 to correct an error. No new matter has been added.

Reexamination and allowance of claims 1-48 and 51-55 are respectfully requested.

### **Claim Rejections**

Claims 1, 28-30, 32, 33, and 35-40 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2003/0055483 to Gumm (hereinafter "Gumm"). Applicants respectfully traverse the rejection.

Claim 1 recites, in part, a proximal collar engaged to a catheter shaft and a distal collar engaged to the catheter shaft, each collar having a nonactivated state and an activated state. In the nonactivated state, a distal balloon waist is rotatable about the distal collar and a proximal balloon waist is rotatable about the proximal collar. In the activated state, the proximal collar is expanded to sealingly engage the proximal balloon waist and the distal collar is expanded to sealingly engage the distal balloon waist.

Gumm does not disclose or suggest proximal and distal collars about which proximal and distal waists of a balloon rotate when the proximal and distal collars are in a nonactivated state and which expand to sealingly engage the proximal and distal balloon waists when in an activated state. In fact, Gumm does not even disclose or suggest proximal and distal collars having activated and nonactivated states.

The Office Action asserts "a reference needs not show the structure of the recitation in order to meet the claim language, but rather the reference needs only be capable of being used with such structure." No citation is provided for this assertion. This assertion is legally incorrect. According to the Manual of Patent Examining Procedure:

[F]or anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. MPEP 706.02 (IV) (emphasis added).

Gumm does not teach proximal and distal collars that allow rotation in a nonactivated state and that expand to sealingly engage balloon waists in an activated state. Further,

such collars are not inherent in Gumm. Rather, the proximal and distal rotating members in Gumm are sealed to (or integrally formed with) the waists of the balloon. See *Gumm* at paragraph [0041].

Moreover, this assertion also is legally incorrect with respect to an obviousness rejection. According to the Manual of Patent Examining Procedure, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (III) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis modified). The MPEP further states "the claimed combination cannot change the principles of operation of the primary reference or render the reference inoperable for its intended purpose." See MPEP 2143.01 (V). Modifying the rotating members 24, 26 of Gumm would destroy the functionality of the balloon in Gumm. If the balloon ends are not sealingly joined to the rotating members of Gumm, then the balloon cannot be filled with inflation fluid and, accordingly, cannot be expanded to complete delivery of a stent carried by the balloon.

The Office Action also asserts "that fig. 2 of Gumm can be clearly defined [sic] a distal balloon waist 32 is capable of rotating about a distal collar 26 and a proximal balloon waist 30 is capable of rotating bout [sic] a proximal collar [24] when the collars 24, 26 are in nonactivated states. Applicants respectfully disagree with this statement. The balloon ends 30, 32 are disclosed as being sealingly joined (or integrally formed with) the rotating members 24, 26. Accordingly, the balloon ends 30, 32 cannot rotate about the rotating members 24, 26. Furthermore, no disclosure or suggestion is made in Gumm of the rotating members having different states (e.g., activated and nonactivated).

The Office Action also asserts "it would have some sort of rotation with the balloon in Gumm when element [sic] 24 and 26 rotate." Applicants agree a balloon can rotate about a catheter in Gumm when rotating members 24, 26 rotate about the catheter. However, the disclosure in Gumm of such rotation is not sufficient to anticipate claim 1. The concurrent rotation of the balloon and rotating members about the catheter of Gumm

is not the same as the rotation of proximal and distal balloon waists about proximal and distal collars as recited in claim 1.

For at least these reasons, Gumm does not anticipate claim 1. Furthermore, Applicants assert no motivation is found in Gumm or elsewhere to modify the balloon of Gumm to enable the balloon ends to rotate about the rotating members of Gumm. As noted above, such a modification would destroy the functionality of the balloon in Gumm. No suggestion is made in Gumm or elsewhere to enable fluid to enter the balloon if the balloon ends in Gumm are not sealingly engaged to the rotating members.

Claims 28-30, 32, 33, and 35-40 depend from claim 1 and are allowable over Gumm for at least the same reasons as claim 1. Withdrawal of the rejection and allowance of claims 1, 28-30, 32, 33, and 35-40 are respectfully requested. Applicants do not otherwise concede the correctness of the rejection and reserve the right to make additional arguments if necessary.

Claims 16-19 and 31 have been rejected under 35 U.S.C. 103(a) as unpatentable over Gumm in view of U.S. Patent No. 6,315,790 to Gerberding et al. (hereinafter "Gerberding"). Applicants respectfully traverse the rejection.

Claims 16-19 and 31 depend from claim 1. Accordingly, claims 16-19 and 31 are allowable over Gumm for at least the same reasons discussed above with respect to claim 1. Gerberding does not overcome the shortcomings of Gumm. Gerberding also does not disclose or suggest proximal and distal collars about which proximal and distal waists of a balloon rotate when the proximal and distal collars are in an activated state and which expand to sealingly engage the proximal and distal balloon waists when in the activated state.

For at least these reasons, Gumm would not lead a person skilled in the art to the inventions of claims 16-19 and 31, even in view of Gerberding. Withdrawal of the rejection and allowance of claims 16-19 and 31 are respectfully requested. Applicants do not otherwise concede the correctness of the rejection and reserve the right to make additional arguments if necessary.

Claim 34 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Gumm in view of U.S. Publication No. 2001/0032013 to Marton (hereinafter "Marton"). Applicants respectfully traverse the rejection.

Claim 34 depends from claim 1 and is allowable over Gumm for at least the same reasons as discussed above with respect to claim 1. Marton does not overcome the shortcomings of Gumm. Marton also does not disclose or suggest proximal and distal collars about which proximal and distal waists of a balloon rotate when the proximal and distal collars are in an activated state and which expand to sealingly engage the proximal and distal balloon waists when in the activated state.

For at least these reasons, Gumm would not lead a person skilled in the art to the invention of claim 34, even in view of Marton. Withdrawal of the rejection and allowance of claim 34 are respectfully requested. Applicants do not otherwise concede the correctness of the rejection and reserve the right to make additional arguments if necessary.

Claim 41-46 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gumm in view of U.S. Publication No. 2002/0107330 to Pinchuk et al. (hereinafter "Pinchu"). Applicants respectfully traverse the rejection.

Claims 41-46 and 51-55 depend from claim 1 and are allowable over Gumm for at least the same reasons as discussed above with respect to claim 1. Pinchuk does not overcome the shortcomings of Gumm. Pinchuk also does not disclose or suggest proximal and distal collars about which proximal and distal waists of a balloon rotate when the proximal and distal collars are in an activated state and which expand to sealingly engage the proximal and distal balloon waists when in the activated state.

For at least these reasons, Gumm would not lead a person skilled in the art to the invention of claims 41-46 and 51-55, even in view of Pinchuk. Withdrawal of the rejection and allowance of claims 41-46 and 51-55 are respectfully requested. Applicants do not otherwise concede the correctness of the rejection and reserve the right to make additional arguments if necessary.

**Conclusion**

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.



Date: July 30, 2008

Respectfully submitted,

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